

REMARKS/ARGUMENTS

As of the Office action mailed March 24, 2004, claims 14 through 30 are pending with all claims standing rejected. Reexamination and reconsideration of the application as amended and in view of the remarks herein is respectfully requested.

As an initial matter, the claims were objected to for a number of minor informalities. The claims have been amended throughout consistent with the Examiner's suggestions. The claims have also been amended throughout to correct minor grammatical errors. No new matter is believed entered by these amendments.

Claim rejections under 35 USC §112

Claim 14-26 and 30 were rejected under 35 USC §112, second paragraph, as being indefinite. Claims 14, 26, and 30 have been amended to overcome the rejections under §112, second paragraph. Applicant respectfully requests that the rejections of claims 14-26 and 30 under 35 USC §112, second paragraph, be withdrawn upon consideration of the various amendments to claims 14, 26, and 30.

Particularly, claim 14, lines 3-4 have been amended to replace "a single bus slot" with -- said single bus slot--, thereby clearly referring to the previously introduced single bus slot. No new matter is added by this amendment. It is respectfully requested that the rejection of claims 14-26 be withdrawn in consideration of this amendment.

Furthermore, claim 26 has been amended to replace "said processor" with --a processor--, thereby obviating the need for antecedent basis. No new matter is added by this amendment.

Finally, claim 30 has been amended to replace “said device” with --said expansion card--. It is submitted that it is now clear which device is referred to by the relevant passage of claim 30. No new matter is believed entered by this amendment.

Claim rejections under 35 USC §102

Claims 14-16, 18-21, 23, and 25 were rejected under 35 USC §102(e) as being anticipated by Emerson et al. (US Patent No. 6,664,969). Independent claim 14 has been amended herein to recite, *inter alia*, “said second embedded device being capable of responding to registers that are queried by an operating system for a PCI-to-PCMCIA bridge so that said operating system detects the presence of a PCI-to-PCMCIA bridge”

By contrast to the claimed interaction between the second embedded device of the claimed expansion card and the operating system, recited by independent claim 14, Emerson et al. discloses a system including “special circuitry and software [that] operate without regard to the existence or type of OS present on the managed server S.” Col. 3, l. 58-60. As the device disclosed by Emerson et al. “operate[s] without regard to the existence or type of OS” Emerson et al. does not teach the claimed limitation of “said second embedded device being capable of responding to registers that are queried by an operating system for a PCI-to-PCMCIA bridge so that said operating system detects the presence of a PCI-to-PCMCIA bridge”.

In view of the shortcomings of Emerson et al., it is respectfully submitted that all of the aspects and features of the invention claimed in claims 14,-16, 18-21, 23, and 25 are neither taught, nor suggested, by Emerson et al. It is respectfully requested that the rejection of these claims as anticipated by Emerson et al. be withdrawn upon reconsideration.

Claims 14, 16, 19, 20, 23-4, and 25 were also rejected under 35 U.S.C. §102(e) as being anticipated by Kamepalli (U.S. Patent no. 6,647,434). Applicant respectfully traverses the rejection as follows.

As the reference is understood by Applicant, Kamepalli discloses a “[m]ultifunction device 121 includ[ing] multiple devices (functions) that are operably coupled to system processor 102 via PCI bus 123.” Col. 3, l. 31-33. The disclosed system “allows for a function to be disabled without disabling the other functions of the multifunction device.” Col. 1, l. 65-67. As shown in FIG. 2 of Kamepalli, the multiple devices, or functions, F1-F7 are coupled to the PCI bus 123 via a PCI interface 205.

Herein, independent claim 14 has been amended to recite “said second embedded device being capable of responding to registers that are queried by an operating system for PCI-to-PCMCIA bridge so that said operating system detects the presence of a PCI-to-PCMCIA bridge.” Kamepalli, however, does not disclose any of the multiple devices (functions) being “capable of responding to queries by an operating system … so that the operating system detects the presence of a PCI-to-PCMCIA bridge.”

As shown in FIG. 2 of Kamepalli, the multifunction device 121 includes a PCI interface 205 allowing the multiple devices to operate on a PCI bus. All of the devices (functions) of the multifunction device 121 operate through the PCI interface 205. Kamepalli does not disclose, or even suggest, that any of the devices (functions) are capable of responding to registers that are queried by an operating system … so that said operating system detects the presence of a PCI-to-PCMCIA bridge.

In view of the amendments to the claims and the foregoing remarks, it is respectfully submitted that Kamepalli fails to teach, or even suggest, all of the elements of independent claim

14, and claims 16, 19, 20, 23-23, and 25 ultimately depending upon claim 14. Accordingly, it is respectfully requested that the rejection of these claims be withdrawn upon reconsideration.

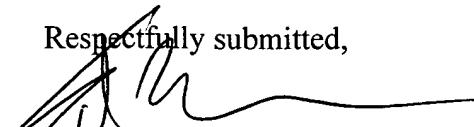
Claim Rejections Under 35 USC §103

Claims 17, 22, 26-30 were rejected under 35 U.S.C. §103(a) as being obvious over Emerson et al. Both independent claims 14 and 27 require that the second embedded device is “capable of responding to registers that are queried by an operating system for a PCI-to-PCMCIA bridge so that said operating system detects the presence of a PCI-to-PCMCIA bridge”. As discussed at length above, Emerson et al. does not teach or even suggest such a feature. In fact, Emerson et al. teaches away from the claimed configuration by specifically requiring that the disclosed device “operate without regard to the existence or type of OS”. Accordingly, Applicant respectfully submits that neither independent claim 14 or 27 is obvious over Emerson et al. Similarly, dependent claims 17, 22, 26, and 28-30, ultimately depending upon either claim 14 or claim 17, are also not obvious over Emerson et al. Applicant respectfully requests that these rejections be withdrawn upon reconsideration.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our deposit account No. 50-2121.

In the event the Examiner deems personal contact is necessary, please contact the undersigned attorney at (603) 668-6560.

Respectfully submitted,


Edmund P. Pfleger
Attorney for Applicants
Reg. No. 41,252